

REMARKS

This paper is responsive to an Office Action mailed September 12, 2008. Prior to this response, claims 1-27 were pending. After amending claims 1 and 14, claims 1-27 remain pending.

In Section 5 of the Office Action claims 1, 3-14, and 16-27 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Nishikawa et al. ("Nishikawa"; US 6,934,046) in view of Freedman (US 4,839,829). With respect to claims 1 and 14, the Office Action acknowledges that Nishikawa fails to disclose merger performance analysis, or determining if the joining of print jobs exceeds the job joining overhead. The Office Action states that Freedman discloses the performance of a merger analysis to determine the economy of job joining, and that it would have been obvious to combine references in order to quickly access a customer's printing requirements with regard to the capacity or capabilities of numerous printing facilities. This rejection is traversed as follows.

Nishikawa discloses a print system that converts all print instructions into an intermediate code that is output to the spooler file 303 and called a page description file (PDF), see col. 7, ln. 52-55 and col. 8, ln. 14-18. Once it is determined that a printing operation is to be performed, the spool file sends the PDF to the despooler 305 where the GDI function is regenerated (col. 8, ln. 40-46). The Applicant submits that Nishikawa is describing EMF spooling – a process that defers print data generation until after the jobs have been joined together.

As acknowledged in the Office Action, Nishikawa does not disclose a merger analysis to determine the economy of joining print jobs, or rendering the print job at a single imaging device. Further, Nishikawa fails to disclose to joining of a plurality of print jobs into a single joined print job (regardless of the economy of doing so).

Freedman discloses a system for interfacing to a computer facility through a computer network. The system collects parameters regarding user needs, such as cost, photos, pictures, graphics, deadlines, number of documents to be printed, colors, paper type, and typeface. The system compares these user parameters with various printing facilities, considering printing equipment issues such as offset presses, paper cutters, and binding equipment, as well as operating costs, time, process requirements. The system evaluates which printing facility is most compatible with the user parameters (col. 1, ln. 1-31).

Generally, Freedman discloses a process for obtaining a print job estimate. In some aspects (Fig. 3A), it appears as if Freedman's system permits a job to be modified after a printing facility has been selected. However, Freedman's print job is not in an electronic format, and Freedman does not disclose the sending of a print job from a client device terminal 14 to a printing facility terminal 38 in an electronic format. To more clearly distinguish the claimed invention print job from Freedman's, claims 1 and 14 have been amended to define a print job as an electronic document in a print data language.

In particular, the claimed invention does not interface to a printing facility, but rather, to a single imaging device. Further, the claimed invention does not evaluate a printing facility, the printing

equipment employed by a printing facility, or any other issues associated with physical act of printing a paper medium document. Rather, the claimed invention recites one narrow type of analysis: whether it is economical to join a plurality of (electronically formatted) print jobs. Freedman's system performs an analysis of printing facilities after the user manually enters job parameters. Freedman's system does not analyze an electronically formatted print job. Freedman's system does not perform an analysis of whether it is economical to join a plurality of electronically formatted print jobs into a single electronically formatted print job. The claimed invention job *joining* analysis has nothing to do with the analysis of color, paper type, and other *printing* analysis criteria.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, the *KSR International Co. v Teleflex Inc.* decision (82 USPQ2d 1385, 1395-1397, 2007) suggests 7 exemplary rationales to support a conclusion of obviousness, which include:

A) Combining prior art elements according to known methods to yield predictable results;

B) Simple substitution of one known element for another to obtain predictable results;

C) Use of known technique to improve similar devices (methods, or products) in the same way;

D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

E) "Obvious to try" – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

G) Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

The Office Action states that modifications to Nishikawa would have been obvious to one of ordinary skill in the art in light of Freedman. This rejection appears to be most closely grounded in the G) rationale - Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

With respect to this rationale, MPEP 2143 (G) states that the rejection must articulate the following criteria to resolve the *Graham* factual analysis:

(1) a finding that there was some teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings;

(2) a finding that there was a reasonable expectation of success; and

(3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

With respect to the above-referenced first factual analysis criteria, the Freedman reference has been combined with Nishikawa based upon the assumption that the combination discloses every limitation recited in Applicant's claims 1 and 14. However, neither Nishikawa nor Freedman discloses a process that performs a job joining analysis, to determine if the economy of joining the jobs exceeds the overhead associated with joining. The Office Action acknowledges that Nishikawa fails to disclose a job joining or job joining overhead analysis. As noted above, Freedman determines the best match between job parameters and printing facilities. Freedman does not make a determination of if it economical to join a plurality of electronically formatted print jobs into a single print job, prior to rendering the joined print job into a single continuous print job. Therefore, even if elements from Freedman are combined with Nishikawa, that combination does not explicitly disclose every limitation of claims 1 and 14. Claims 3-13, dependent from claim 1, and claims 16-27, dependent from claim 14, enjoy the same advantages.

The Office Action states that the motivation to combine references stems from impediments incurred in the routine business practices of the printing industry, and that it would have been obvious to combine Freedman's cost-cutting analysis with Nishikawa's print processing method. However, neither Nishikawa nor the claimed invention recites any limitations associated with the printing industry. Since Nishikawa discloses a print system that converts the print instructions associated with an electronically formatted print job into an

intermediate code for processing, the Applicant submits that there little motivation to combine Nishikawa's process with a system for selecting a printing facility. More important, even if a practitioner would have been motivated to combine Nishikawa with Freedman, that combination does not suggest the desirability or economy of rendering a plurality of electronically formatted print jobs as a single print job.

Neither Nishikawa nor Freedman discuss the measurement of overhead associated with joining print jobs, and the Office Action does not explain the logical steps between selecting a printing facility based upon job parameters, and the claimed invention job joining analysis. Without the suggestion, or means of performing this overhead analysis, the combination of references cannot be said to suggest the joining of a plurality of print jobs on the basis of economy.

A *prima facie* analysis of motivation is especially critical since the rejection is predicated on limitations that are not explicitly disclosed in the prior art references. The claimed invention can only be obvious if an artisan makes substantial modifications to the Nishikawa reference. However, the Freedman reference does not suggests that there is a potential economy to joining a plurality of electronically formatted print jobs, or that this potential economy can be traded-off against considerations of job joining overhead.

Neither does the obviousness rejection provide evidence that such modifications would have been obvious to one with skill in the art based upon what was well known at the time of the invention. "(A)nalysis [of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the

challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007). However, if the *prima facie* rejection is supported by what was known by a person of ordinary skill in the art then additional evidence should have been provided. Notable, when the source or motivation is not from the prior art references, “the evidence” of motive will likely consist of an explanation or a well-known principle or problem-solving strategy to be applied”. *DyStar*, 464 F.3d at 1366, 80 USPQ2d at 1649. The Office Action does not supply evidence that it was well known at the time of the invention to perform a job joining analysis, or a calculation of job joining overhead.

With respect to the second analysis criteria needed to support the G) obviousness rationale, even if a practitioner were given the Nishikawa and Freedman references as a foundation, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention. That is, there can be no reasonable expectation of success if the references, and what was known by artisan at the time of the invention, do not teach all the limitations of the claimed invention.

In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported since the combination of Nishikawa and Freedman does not explicitly disclose every limitation of claims 1 and 14. Neither has a case been supported that Nishikawa can be modified to supply the missing limitations in view of Freedman, or what was well known by a person of skill at the time of the invention.

Therefore, the Applicant requests that the rejection of claims 1, 3-14, and 16-27 be removed.

In Section 6 of the Office Action, claims 2 and 15 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Nishikawa and Freedman in view of Reilly (US 6,052,147). The Office Action acknowledges that Nishikawa and Freedman fail to disclose a print server, but that Reilly discloses such a feature, and that it would have been obvious to combine references, with the motivation being that the combination of a printer and print server reduces costs. This rejection is traversed as follows.

The Reilly reference has been combined with Nishikawa/Freedman predicated upon the assumption that the combination of Nishikawa and Freedman discloses all the limitations of independent claims 1 and 14. However, as noted above in the discussion of claims 1 and 14, the combination of Nishikawa/Freedman fails to disclose an analysis of job joining economies or the calculation of the overhead associated with joining a plurality of jobs. Therefore, even if Reilly is combined with Nishikawa/Freedman, the combination still fails to disclose the above-mentioned limitations. Claim 2, dependent from claim 1, and claim 15, dependent from claim 14, enjoy the same advantages.

The Office Action states it would have been obvious to combine a printer and print server to reduce costs. However, this statement does not explain how a practitioner in the art could have modified the references to yield all the claimed invention limitations. As explained above, even when combined, Reilly, Nishikawa, and Freedman

fail to disclose all of the claimed invention limitations. The above-quoted statement from Office Action does not explain how even a person with skill in the art could have modified Nishikawa's conventional job joining process to enable a process that optionally joins jobs on the basis of a job joining overhead analysis, since neither Reilly nor Freedman describe or suggest these limitations. Alternately stated, the motivation to supply all the limitations missing in the references cannot be inspired by a desire to reduce costs. Such an assertion does not explain how a practitioner could have arrived at the Applicant's claim limitations to achieve the goal of reducing costs. Rather, there must be an explicit teaching in the Reilly reference that shows a practitioner how Nishikawa/Freedman can be modified to yield the claimed invention. Such a *prima facie* case has not been made.

Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to Nishikawa that would make all the limitations obvious, the Applicant requests that the rejection of claims 2 and 15 be withdrawn.

Applicant asserts that the claims are patentable over the references made of record. It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

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/Mali/
Gerald Maliszewski
Registration No. 38,054

Customer Number 55,286
P.O. Box 270829
San Diego, CA 92198-2829
Telephone: (858) 451-9950
Facsimile: (858) 451-9869
gerry@ipatentit.net